

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 18,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SWIMC, Inc.

Serial No. 75/036,059

Robert E. McDonald of The Sherman-Williams Company
for applicant.

Hannah Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Sams, Cissel and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

The Sherman-Williams Company filed an application to
register the mark FERRO-PREP for "surface cleaners for use
in the automotive industry."¹ The application was
subsequently assigned to SWIMC, Inc. and the assignment was
recorded by the Assignment Branch of the Office.²

¹ S.N. 75/036,059, filed Dec. 22, 1995, claiming first use dates
of Dec. 20, 1995.

² Reel 1463, Frame 0347, recorded May 14, 1996.

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant and the Examining Attorney filed briefs, but no oral hearing was requested.

The Examining Attorney maintains that the term FERRO-PREP merely describes the purpose of the goods and the substrate on which it is used, i.e., that it is a cleaner used to condition or prepare iron and related surfaces for further use in the automotive industry. To support this position, she has made of record dictionary definitions of "ferro" as a prefix meaning "iron" and of "prep" as the shortened form for the word "preparation" or, in other words, "the action or process of making something ready for use or service."³ In addition, she has introduced synonyms listed in Roget's International Thesaurus for the word "preparation," including the term "conditioning." She has also shown by dictionary definition that "steel" consists of an alloy of iron and carbon. As additional evidence of the descriptive nature of the term FERRO-PREP as used in connection with applicant's goods, the Examining Attorney has pointed to the specimens of record, which consist of labels for the FERRO-PREP "steel cleaner" which "deep

³ Webster's Ninth New Collegiate Dictionary (1983).

cleans and conditions metal substrates," "removes oxidation, rust and corrosion," "insures paint adhesion and promotes corrosion protection," and which is suitable for various steel and iron substrates.

Applicant argues that its mark is at most suggestive, and that neither FERRO or PREP directly calls to mind a cleaner. Applicant contends that a consumer would be unable to immediately determine from the mark FERRO-PREP that it refers to a surface cleaner, but rather it would require imagination, even on the part of one skilled in the automotive field, to identify the product as such.

Applicant argues that one must first convert FERRO to "iron," then PREP to "preparation" or "condition", then "iron preparation" or "iron conditioner" to surface cleaner. Applicant points to several third-party registrations in which either FERRO or PREP has been found capable of functioning as a portion of the mark and not merely descriptive.

A word or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately convey information about a characteristic, purpose, function, or feature of the goods with which it is being used. Whether or not a mark is merely descriptive is not determined in

the abstract, but in relation to the goods or services for which registration is being sought. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Thus, we must determine whether or not FERRO-PREP is merely descriptive, when used in connection with applicant's surface cleaners for use in the automotive industry. The issue is not what the connotation of the mark is, standing alone.⁴ We start with the fact that the Examining Attorney has shown that FERRO-PREP is the equivalent in meaning to "iron prep" or "iron conditioner." Next we consider the goods on which the mark is being used, namely, surface cleaners for use in the automotive industry. We agree with the Examining Attorney that the purchasers of these goods would be familiar with the various functions of surface cleaners used in this field. As a result, we do not believe that any great amount of imagination or deductive reasoning would be involved for these purchasers to determine that a FERRO-PREP surface cleaner would function to prep or condition iron or iron alloy (steel) surfaces. The mark FERRO-PREP immediately

⁴ The Board does not follow the test set forth in *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F. Supp 479, 160 USPQ 777 (SDNY 1968), but rather the standard set forth by our principal reviewing court in *In re Abcor Development Corp.*, *supra*.

and directly conveys this information to potential purchasers. The material on the labels of the goods with which the mark is being used serves to demonstrate the correctness of this interpretation of applicant's mark.

While applicant has relied upon *In re Colgate-Palmolive Company*, 406 F.2d 1385, 160 USPQ 733 (CCPA 1969), in which the mark CHEW 'N CLEAN was held not merely descriptive of a dentifrice, as support for the registrability of its mark, the situation here is not the same. There the mark referred to two distinct features of the goods, one that the user chewed the dentifrice, and the other that the dentifrice itself cleaned. The mark as a whole was not merely descriptive of a function of the goods, but rather consisted of a suggestive and somewhat fanciful combination of a feature and a function. By contrast, here the mark is directed solely to the major function of the goods, it is a surface cleaner which acts as a FERRO-PREP, i.e., an iron prep or conditioner.

On the other hand, we find the cases cited by the Examining Attorney to be of some assistance here. In *Ferro Corp. v. Quaker Chemical Corp.*, 404 F.2d 619, 160 USPQ 41 (CCPA 1968), the Court agreed with the Board's holding that the prefix "ferro" would more likely be associated with its well known meaning "iron" than with the opposer's mark

FERRO. Although applicant argues that the subsequent dismissal of the opposition against registration of the mark FERROCOTE for a rust preventative supports the registrability of its FERRO-mark, this argument is not well founded. The ground for opposition was likelihood of confusion, not descriptiveness. The fact that the opposition was dismissed points to the weakness of the term FERRO when used as an indicator of source, in comparison with its more common use as a prefix meaning "iron."

In a similar vein, the Examining Attorney has cited *Marion Laboratories, Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215 (TTAB 1988) for the statement therein that the suffix PREP in the mark TOXI-PREP is simply "a portion of the descriptive term 'preparation'." While applicant argues that this is only dicta and evidence of no more than that the word "preparation" may be descriptive, we still consider this precedent for the proposition that PREP may be viewed as the equivalent of "preparation", and, depending upon the particular goods involved, may be descriptive.

Applicant has also cited various third-party registrations for marks containing either FERRO or PREP as a portion thereof. While the Examining Attorney only objected to the registrations in her brief on the basis

that applicant had failed to submit soft copies of the registrations, and appears to have actually considered the registrations in her final refusal,⁵ we still can give no weight to the registrations. Applicant has only set forth the marks; we have no indication of the goods and/or services for which these marks are registered. The fact that FERRO or PREP may have not been considered descriptive when used in connection with totally different goods and/or services is irrelevant.⁶

Accordingly, we find the mark FERRO-PREP to be merely descriptive when used in connection with surface cleaners for use in the automotive industry.

Decision: The refusal under Section 2(e)(1) is affirmed.

J. D. Sams

R. F. Cissel

H. R. Wendel

⁵ By her consideration of the registrations at this point, the Examining Attorney waived any right to object to the evidence in her brief.

⁶ We have given no consideration to the third-party registrations first introduced by the Examining Attorney in her brief. Applicant cited its third-party registrations in its response to the initial Office action and thus any rebuttal evidence of the Examining Attorney should have been produced in the final refusal. See Trademark Rule 2.142(d).

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Trademark Administrative Judges,
Trademark Trial and Appeal Board

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